



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,392	09/29/2000	Aditya Mukherjee	042390.P9572	3111

7590 11/19/2003

BLAKELY, SOKOLOFF  
TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025

EXAMINER
----------

CHAUDRY, MUJTABA M

ART UNIT	PAPER NUMBER
----------	--------------

2133

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/677,392

Applicant(s)

MUKHERJEE, ADITYA

Examiner

Mujtaba K Chaudry

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The corrected or substitute drawings were received on June 12, 2003. These drawings are accepted.

### ***Specification***

The corrected or substitute specification were received on June 12, 2003. The specification is accepted. In particular, the amendments made to the abstract are accepted.

### ***Response to Amendment***

Applicant's arguments/amendments with respect to amended claims 1, 6, 10, 18 and 19 and original claims 2-5, 7-9, 11-17 and 20 filed June 12, 2003 have been fully considered but are not persuasive. As per claims rejections under 35 USC 112, second paragraph, they have been withdrawn. The Examiner would like to point out that this action is made final (MPEP 706.07a).

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies are not recited in the rejected claim(s). For example, Applicant contends, "Wasson (prior art of record) does not disclose teach or suggest the IC tester is such that it is embedded on the IC to be tested." These limitations are not recited in the claims of the present application. However, even if it was to be introduced into the claim language, Wasson does in fact teach this limitation. The Examiner would like to point out that Wasson specifically teaches "Figure 1 to be an integrated circuit (IC) tester," which includes the device under test on the integrated circuit; hence the IC tester is embedded on the IC to be tested. Furthermore, the Applicant is reminded that even if the IC

Art Unit: 2133

tester were not embedded onto the IC under test, it would not make it patentability distinct. It would have been an obvious design choice. See *In Re Larson*, 144 USPQ 347 (CCPA 1965).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant contends, "Wasson does not teach, disclose or suggest all the limitations contained in Applicant's amended claims." The Examiner disagrees. The newly added limitations are taught by Wasson, for example, Wasson teaches (col. 3, lines 19-43) an integrated circuit (IC) tester in accordance that includes set of tester channels, each for carrying out a test activity at a separate terminal of an IC device under test (DUT) during each cycle of a test. The tester also includes a disk drive having a removable disk for reading out scans or programming data to the tester channels during a test. Each tester channel includes **an instruction memory for storing a set of instructions**, and each channel executes its stored instructions during the test. Some of the instructions include VECTOR data directly indicating a particular test activity the channel is to carry out at a DUT terminal during a next test cycle. Others of the instructions tell the channel to acquire a particular number (N) of serial data bits as they are read out of the disk drive and to carry out an activity during each of the next N test cycles indicated by a state of a corresponding one of the N serial data bits. Furthermore, Wasson teaches (col. 4, lines 17-53) the tester (10) is adapted for testing DUTs of the type having in addition to a set of logic signal input and output terminals, a set of "scan" terminals enabling the tester to ascertain states of internal DUT nodes not otherwise accessible via normal DUT output terminals. When **tester supplies an appropriate serial data sequence to one of the DUT's scan terminals, while holding normal**

Art Unit: 2133

**DUT logic signal input and output terminals at fixed states, DUT 14 produces an output data sequence at another of its scan terminals indicating the current states of various internal DUT nodes.**

***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasson (USPN 6181151 B1). (See office action, paper No. 6)

The Examiner disagrees with the Applicant and maintains all rejections with respect to amended claims 1, 6, 10, 18 and 19 and original claims 2-5, 7-9, 11-17. All arguments have been considered. It is the Examiner's conclusion that amended claims 1, 6, 10, 18 and 19 and original claims 2-5, 7-9, 11-17 are not patentably distinct or non-obvious over the prior art of record (See paper No. 6).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

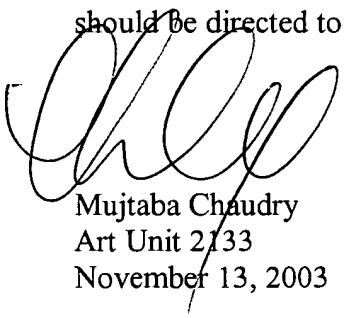
Art Unit: 2133

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiries concerning this communication should be directed to the examiner, Mujtaba Chaudry who may be reached at 703-305-7755. The examiner may normally be reached Mon – Thur 7:30 am to 4:30 pm and every other Fri 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Albert DeCady at 703-305-9595. The fax phone number for the organization where this application is assigned is 703-746-7239.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the receptionist at 703-305-3900.



Mujtaba Chaudry  
Art Unit 2133  
November 13, 2003



ALBERT DECADY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100